

REMARKS/ARGUMENTS

The Office Action mailed November 14, 2008 has been carefully reviewed. Reconsideration of this application, as amended and in view of the following remarks, is respectfully requested. The application originally contained claims 1-93. Applicants elected claims 1, 9, 20, 26, 50 and 61 in response to the restriction requirement. Claims 2-8, 10-19, 21-25, 27-49, 51-60, and 62-93 stand withdrawn. The claims presented for examination are: claims 1, 9, 20, 26, 50, and 61.

Restriction Requirement

In numbered paragraph 1 of the Office Action mailed November 14, 2008 the followings statements were made:

“Applicant's election without traverse of Species V in the reply filed on January 24, 2008 is acknowledged. In the response submitted July 28, 2008, applicants have amended claim 1 to recite that the magnetic pieces as being Ni-Zn-Fe-O magnetic material. In view of this amendment, the Examiner now considers that claim 1 is included in the elected claims directed to the Ni-Zn-Fe-O embodiment. Accordingly, the Examiner now considers that claims 1, 9, 20, 26, 50 and 61 read on a shape memory material body comprising a Ni-Zn-Fe-O powder. Applicants in their next response should indicate what additional claims from among product claims 1 to 82 they consider to be encompassed by the elected claims 1, 9, 20, 26, 50 and 61.”

Applicants have reviewed claims 1-93 and determined there are no additional claims among product claims 1 to 82 that Applicants consider to be encompassed by the elected claims 1, 9, 20, 26, 50 and 61.

Nonstatutory Obviousness-type Double Patenting Rejection

In numbered paragraph 3 of the Office Action mailed November 14, 2008 claims 1, 9, 20, 26, 50 and 61 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 to 40 of copending Application No. 10/717,225. Note that the serial number of Applicants' copending application is 10/177,225.

"Although the conflicting claims are not identical, they are not patentably distinct from each other because the shape memory polymer device recited in the claims of '225 overlaps the shape memory material apparatus recited in the instant claims. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented."

"A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b)."

Applicants' Copending Application Serial No. 10/177,225 is commonly owned with the subject application as established by assignments recorded in the United States Patent and Trademark Office. Applicants' Copending Application Serial No. 10/177,225 and the subject application were assigned to The Regents of the University of California. Because of a change of contractors for the Lawrence Livermore National Laboratory from the University of California to Lawrence Livermore National Security, LLC, Applicants' Copending Application Serial No. 10/177,225 and the subject application have been further assigned to Lawrence Livermore National Security, LLC as successor in interest to The

Regents of the University of California as operator of the Lawrence Livermore National Laboratory.

Enclosed herewith is a terminal disclaimer in compliance with 37 CFR 1.321(c), disclaiming the terminal portion of any patent issue from this application which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173 of Applicants' Copending Application Serial No. 10/177,225.

Applicants believe they have provided a full and complete response to the obviousness-type double patenting rejection in numbered paragraph 3 on page 3 of the Office action mailed November 14, 2008.

Prior Art Under 35 U.S.C. 103(a), 102(e), (f) or (g) Rejection

Numbered paragraph 4 of the Office Action mailed November 14, 2008 included the following statements:

"Claims 1, 9, 20, 26, 50 and 61 are directed to an invention not patentably distinct from claims 1 to 40 of commonly assigned US Patent Application No. 10/717,225. Specifically, the shape memory polymer device recited in the claims of '225 overlaps the shape memory material apparatus recited in the instant claims."

"The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned 10/717,225, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter."

“A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.”

Note that the serial number of Applicants' Copending Application is 10/177,225 and not 10/717,225 as stated in the Office Action mailed November 14, 2008. Applicants' Copending Application Serial No. 10/177,225 is commonly owned with the subject application as established by assignments recorded in the United States Patent and Trademark Office. Applicants' Copending Application Serial No. 10/177,225 and the subject application were assigned to The Regents of the University of California. Because of a change of contractors for the Lawrence Livermore National Laboratory from the University of California to Lawrence Livermore National Security, LLC, Applicants' Copending Application Serial No. 10/177,225 and the subject application have been further assigned to Lawrence Livermore National Security, LLC as successor in interest to The Regents of the University of California as operator of the Lawrence Livermore National Laboratory.

Applicants believe they have provided a full and complete response to the 103(a), 102(e), (f) or (g) rejection in numbered paragraph 4 on pages 3 and 4 of the Office action mailed November 14, 2008.

35 U.S.C. 103(a) Rejection

In numbered paragraph 5 of the Office Action mailed November 14, 2008 claims 1, 9, 20, 26, 50 and 61 were rejected under 35 U.S.C. 103(a) as being obvious over 10/717,225. Note that the serial number of Applicants' Copending Application is 10/177,225.

Numbered paragraph 6 of the Office Action mailed November 14, 2008 included the following statements:

"The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(1)(1) and § 706.02(1)(2) the shape memory polymer device recited in the claims of '225 overlaps the shape memory material apparatus recited in the instant claims."

Applicants' Copending Application Serial No. 10/177,225 is commonly owned with the subject application as established by assignments recorded in the United States Patent and Trademark Office. Applicants' Copending Application Serial No. 10/177,225 and the subject application were assigned to The Regents of the University of California. Because of a change of contractors for the Lawrence Livermore National Laboratory from the University of California to Lawrence Livermore National Security, LLC, Applicants' Copending Application Serial No. 10/177,225 and the subject application have been further assigned to Lawrence Livermore National Security, LLC as successor in interest to The Regents of the University of California as operator of the Lawrence Livermore National Laboratory.

Enclosed herewith is a terminal disclaimer in compliance with 37 CFR 1.321(c), disclaiming the terminal portion of any patent issue from this application which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173 of Applicants' Copending Application Serial No. 10/177,225.

Enclosed herewith is a Declaration by Eddie E. Scott under 37 CFR § 1.132 stating that, "Any inventions of claims 1, 9, 20, 26, 50 and 61 in the subject application that were disclosed but not claimed in Co-Pending Application Serial No. 10/717,225 were derived from Patrick R. Buckley and Duncan J. Maitland (The Inventors), in the subject application and are not the invention "by another" under 35 USC 102(e)."

Applicants believe they have provided a full and complete response to the 35 U.S.C. 103(a) rejection in numbered paragraph 5 on page 4 of the Office action mailed November 14, 2008.

SUMMARY

Applicants believe they have overcome the rejections in numbered paragraphs 3, 4, and 5 of the Office action mailed November 14, 2008.

The undersigned respectfully submits that, in view of the foregoing the rejections of the claims raised in the Office Action dated November 14, 2008 have been fully addressed and overcome and the present application is believed to be in condition for allowance.

It is respectfully requested that this application be reconsidered, that the claims be allowed, and that this case be passed to issue. If it is believed that a telephone conversation would expedite the prosecution of the present application, or clarify matters with regard to its allowance, the Examiner is invited to call the undersigned attorney at (925) 424-6897.

Respectfully submitted,



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Dated: December 1, 2008